THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KENICHI KANO
and KOKICHI SUGAWARA

_____

Appeal No. 97-2504
Application 08/200,707[1]

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ON BRIEF

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Before KRASS, JERRY SMITH and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

[1] Application for patent filed February 23, 1994.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 and 3. Claims 2 and 4-6 have been cancelled. Claims 7-9 stand withdrawn from consideration as being directed to a nonelected invention.

The claimed invention pertains to a container casing for housing a recording media therein. More particularly, the invention is directed to external layers on the casing which allow for color designs to be formed and areas in which writing can be formed.

Representative claim 1 is reproduced as follows:

1. A container casing for a recording media having a main casing member having the recording media housed therein, comprising:

a highly adhesive layer formed on an outer surface of said main casing member;

an ink receptive layer provided on said adhesive layer;

a colored layer printed on said ink receptive layer;

a protective layer printed on said colored layer for protecting the colored layer; and

means defining an opening in said protective layer for exposing a part of said colored layer and defining an area of said colored layer which is unprotected and on which writing can be formed.

The examiner relies on the following references:

Cocco et al. (Cocco)	4,996,681	Feb. 26, 1991
Sugaya et al. (Sugaya)	2,203,278	Oct. 12, 1988

(UK Patent Application) Kogo	0,383,330	Aug. 22, 1990
(European Patent Application)		

We note that the final rejection included a rejection of claims 1 and 3 under the second paragraph of 35 U.S.C. § 112. Three problems were indicated in paragraphs numbered 1(a) through 1(c) of the final rejection. Appellants filed an amendment after final rejection on August 31, 1995. Although this amendment was denied entry by the examiner, appellants were notified that the Section 112 rejection of paragraphs 1(a) and 1(b) would be overcome by a separately filed amendment [advisory action, Paper #10]. Appellants filed a second amendment after final rejection on January 23, 1996 directed to the rejection under Section 112. The examiner indicated that this amendment would be entered upon appeal and that the Section 112, paragraph 2 rejection of claims 1 and 3 had been overcome [advisory action, Paper #16]. No mention was made of the separate rejections set forth in paragraphs 1(a) through 1(c) of the final rejection. The appeal brief in this case has noted that the Section 112 rejection of paragraphs 1(a) and 1(b) has been overcome, and no further discussion of the Section 112 rejection as set forth in the final rejection is offered. The examiner’s answer repeated the final

rejection of claim 3 as set forth in paragraph 1(c) of the final rejection. Appellants have made no comments with respect to this rejection.

In view of this prosecution history, we must first decide what to do about the Section 112 rejection of claim 3 as set forth in paragraph 1(c) of the final rejection. The examiner's answer has repeated this rejection even though the second advisory action [Paper #16] indicated that the rejection under the second paragraph of 35 U.S.C. § 112 would be overcome by the amendment. The brief ignores this rejection and notes that the rejections of paragraphs 1(a) and 1(b) had been overcome by their after final amendment [brief, page 2]. Thus, we have a situation where appellants may have been misled by the second advisory action indicating that the Section 112 rejection had been overcome, yet appellants appear not to have read the examiner's answer which repeated the rejection and appellants admit that their amendment only overcame the rejection as set forth in paragraphs 1(a) and 1(b) of the final rejection.

Although we do not condone appellants' failure to carefully read the examiner's answer, we do recognize that the second advisory action could have misled appellants into thinking

that all the rejections under Section 112 had been overcome. The Board would ordinarily have the authority to either dismiss the appeal with respect to the claims not argued or to sustain the rejection for lack of a persuasive response. In our view, each of these actions would be unnecessarily punitive under the facts of this case, and particularly when the merits of the Section 112 rejection are considered. Therefore, on this record we will consider the merits of the rejection under 35 U.S.C. § 112.

Thus, claim 3 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention as noted in the examiner's answer. Claims 1 and 3 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Cocco in view of Sugaya with respect to claim 1, Kogo taken alone with respect to claim 3, and Sugaya taken alone with respect to both claims.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence

of obviousness relied upon by the examiner as support for the obviousness rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the invention as recited in claim 3 is in compliance with the second paragraph of Section 112. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1 and 3. Accordingly, we reverse.

We consider first the rejection of claim 3 under the second paragraph of 35 U.S.C. § 112. The complete rejection and explanation are set forth as follows:

> Regarding claim 3, it is not readily apparent whether the “colored layer” is formed with openings to define the “recessed index area”, or the “protective layer” formed over the colored layer defines the claimed “recessed index area”. [answer, page 3].

As the rejection notes, the examiner is of the view that the claim may have either of two possible interpretations. We note that one of the examiner's interpretations would be contrary to the disclosed invention and the other interpretation would be consistent with the claimed invention. In this situation the only appropriate claim interpretation is the one which is consistent with the disclosed invention. Since it is clear from the record as a whole that it is the protective layer only which defines the recessed index area, we interpret the claim in that manner. When the claim is interpreted in light of the specification in this case, we conclude that the claim properly defines the invention within the meaning of 35 U.S.C. § 112. Therefore, we do not sustain the rejection of claim 3 under the second paragraph of 35 U.S.C. § 112.

We now consider the rejections of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the rejection of claim 1 as unpatentable over the teachings of Cocco and Sugaya, the examiner basically relies on Cocco as teaching the claimed invention except for the white ink receptive layer located between the adhesive layer and the colored layer [answer, pages 4-5]. The examiner relies on Sugaya for supplying this teaching, and the examiner submits that

it would have been obvious to include such a layer on the Cocco container casing. Appellants argue that the claims require that the protective layer be "printed on" the colored layer, and this condition is not suggested by either Cocco or Sugaya [brief, pages 5-6]. The examiner responds that the "printing" of this layer is a process limitation which is not relevant to the obviousness of the product claimed. Appellants dispute the examiner's claim interpretation.

The examiner's reliance on "product by process" principles in the examination of the appealed claims is misplaced here. The principle relied on by the examiner is that the process of making cannot be used to patentably distinguish a product which appears to be structurally the same as a prior art product. Before this principle can be used, however, it is necessary to establish that two products are structurally identical to each other. The examiner's finding that the protective layer 36 of Cocco which is clamped onto the colored layer 35 is structurally the same as a protective layer which is "printed on" the colored layer is clearly flawed. The protective layer of Cocco not only would structurally appear different from

a printed on layer to the artisan, but also would have different properties from a printed on layer which would render the two products as not being the same. The examiner must consider the patentability of the claim as a whole including the obviousness of the "printed on" feature of the protective layer. Such determination has not been made here.

The other main difference argued by appellants is that there is no suggestion in the applied references for exposing a part of the colored layer by defining an opening in the protective layer. The examiner argues that as a general rule, it would

have been obvious to the artisan to omit an element of a prior art device and to lose the function of that element. Thus, the examiner contends that selectively removing parts of the protective layer and losing the protection would have been obvious to the artisan. We do not agree.

The prior art places a protective layer over a colored layer for the sole purpose of protecting the colored layer. Any removal of this protective layer would defeat the very purpose of this layer. The artisan, therefore, would not remove any portion of this layer unless there was a benefit to be derived which

would offset the loss of protection. The prior art suggests no benefit to be derived in removing part of the protective layer. Appellants' specification discloses that the ability to write on the exposed portions of the colored layer is a benefit they desire to achieve. In our view, the artisan would find no suggestion for exposing a part of the colored layer from the applied prior art, but rather, such suggestion can only come from appellants' own specification. Such hindsight reconstruction of the invention is improper. Thus, we do not sustain the rejection of claim 1 as unpatentable over Cocco in view of Sugaya.

With respect to the rejection of claim 3 as unpatentable over the teachings of Kogo, the examiner basically asserts that

it would have been obvious to the artisan to place a protective cover over predetermined parts of Kogo's printed color pattern 60 [answer, page 6]. Appellants again argue that the protective layer being "printed" over the colored layer is not taught by Kogo, and that Kogo would teach away from protecting only predetermined portions of the colored layer with the protective layer.

We are again persuaded by both of these arguments. The examiner has not provided any factual support for the position

that a printed protective layer would have been obvious in view of Kogo. There is also no reason suggested by Kogo why the artisan would deliberately leave part of the colored layer unprotected. The only reason for exposing a portion of the colored layer comes from appellants' own disclosure. Thus, we do not sustain the rejection of claim 3 as unpatentable over Kogo.

With respect to the rejection of claims 1 and 3 as unpatentable over the teachings of Sugaya, the examiner basically relies on the same arguments discussed above with respect to the rejection of claim 1 over Cocco and Sugaya. Likewise, appellants point out the same differences argued above with respect to claim 1.

We agree with appellants that Sugaya does not suggest the invention of claims 1 and 3 for the same reasons discussed above. Therefore, we do not sustain the rejection of claims 1 and 3 as unpatentable over the teachings of Sugaya.

In conclusion, we have not sustained any of the examiner's rejections of the claims. Accordingly, the decision of the examiner rejecting claims 1 and 3 is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)

Ronald P. Kananen
Marks & Murase
2001 L Street, N.W., Ste. 750
Washington, DC 20036